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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,970	03/19/2001	Thomas Zermani	MCA-508 US	9265
25182	7590	11/03/2005	EXAMINER	
MILLIPORE CORPORATION 290 CONCORD ROAD BILLERICA, MA 01821			CECIL, TERRY K	
			ART UNIT	PAPER NUMBER

1723

DATE MAILED: 11/03/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/811,970
Filing Date: March 19, 2001
Appellant(s): ZERMANI ET AL.

John Dana Hubbard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-22-2005 appealing from the Office action mailed 12-21-2004.

(12)

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it does not include a concise explanation of the subject matter defined in each of the independent claims and any dependent claim argued separately. The correction follows:

Independent claim 1 requires a filtration device including one or more wells, each having an open top and a closed bottom and one or more holes formed through the closed bottom (page 3, lines 1-7, figures 1-2 elements 1-5). Each well also includes one or more one-piece filters held in place against the bottom of the well by a continuous roll of inner wall material "11" (page 2, lines 5-14, page 3, lines 7-9 and 27-31, figure 1, element 6 and figure 2, elements 11-12).

Independent claim 26 requires 96 wells in addition to the limitations of claim 1.

Art Unit: 1723

Dependent claim 24 (dependent from claim 1), requires the filter to be multiple pieces with the continuous roll of material on top of the upper surface of the uppermost filter (page 5, lines 24-27).

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 1, 11, 16, 24 and 26 appears on pages 8-9 of the Appendix to the appellant's brief. The minor errors are as follows: claim 27 should not be included since the claim has been allowed and is not being appealed.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1723

Claims 1, 10-11, 16 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowers et al. (U.S. 5,108,704).

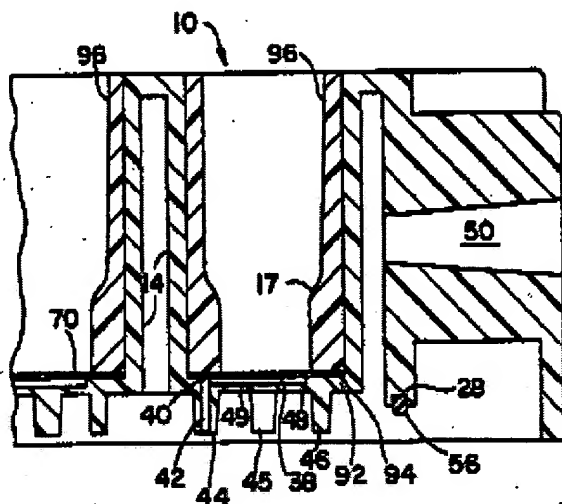


FIG 11

continuous roll of inner wall material formed by shoulder 17 [as in claims 1, 16 and 26]. The filter can be made of paper or cellulose acetate (col. 9, lines 14-23) [as in claims 10-11].

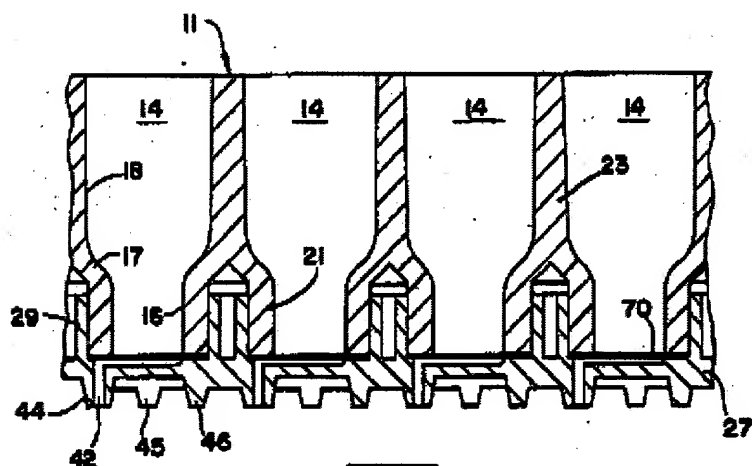


FIG 10

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Aysta et al. (U.S. 5,264,184). Aysta teaches a separation layer 28 held against the bottom of a well by a ring that can be made of a plurality of layers (e.g. bulk material between two porous glass frits, col. 5, lines 50-62) [as in claim 24]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the plurality of layers of Aysta as the filter material 70 of Bowers, wherein upon modification the continuous roll formed by the shoulder 17 of Bowers would contact the top surface of the multi-layer filter of Aysta, since Aysta teaches the benefit of chromatographic properties—desired by Bowers (col. 2, line 37).

(10) Response to Argument

Applicant argues that Bowers does not anticipate the claims because Bowers does not teach “a continuous roll of inner wall material as is required by the claims.” This is not found convincing. Firstly, it is pointed out that the continuous roll of inner wall material that holds the filter against the well bottom is the flange-like element 11 shown in figure 2. Presumably, applicant *names* the element a “continuous roll” because during the process of making the element, it appears as 34 in figure 4. However, the examiner contends that *the final product as claimed* is the same as that of Bowers—i.e. the flange-like element 17 is “of inner wall material” and is positioned atop the filter to hold the filter in place and against the bottom of the well. Applicant also argues that 17 cannot be the continuous roll because the shoulder is “located some ways up the side of the inner wall” and because it is actually annular element 96 that holds the filter 70 in place. This is not found to be convincing since shoulder 17 is part of annular element 96 (the inner wall of the well) and is considered to be the portion of the wall that extends from the leader of “17” to the top surface of the filter.

Applicant argues that Bowers in view of Aysta does not teach all the claimed limitations of claim 24 because Bowers does not teach a continuous roll and the combination of the references does not teach a continuous roll holding a multilayered filter against the well bottom. This is not found convincing since (as explained above) Bowers does teach the claimed continuous roll. Aysta has been relied upon for its teachings of a multilayered filter held in place by an element (retaining ring 30) positioned against the top surface of the uppermost filter layer. Upon modification of Bowers to incorporate the multilayered filter of Aysta, the continuous roll 17 of

Art Unit: 1723

Bowers would hold the multilayered filter against the well bottom thereof. Reasons for modifying Bowers was presented in the final office action. See also col. 5, lines 49-63 of Aysta.

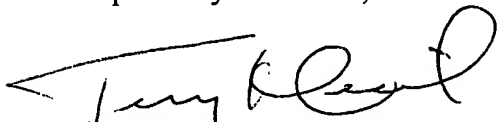
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1723


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Examiner Terry K. Cecil

Conferees:



Wanda L. Walker



Michael Colaiaanni